

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) Douglas B. Wilson
Serial No. 10/720,821
Filed 11/24/2003
Title FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE
Examiner Vinh Luong
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Commissioner for Patents
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REPLY BRIEF UNDER 37 C.F.R. §41.41

SIR:

This is a Reply Brief filed pursuant to 37 C.F.R. §41.41 in response to the Examiner's Answer dated August 3, 2010.

I. GENERAL

This paper is in reply to the Examiner's Answer dated August 3, 2010 ("Answer"). In the Answer, the Examiner stated his basis to support (i) the rejection of claims 20-28 and 39 for anticipation under 35 U.S.C. §102(b) based on JP_H04-78769 to Shigeru ("Shigeru"), (ii) the provisional rejection of claims 20-26 under the judicially created doctrine of obviousness-type double patenting based on claims 14-17, 24, and 27 of co-pending U.S. Application Ser. No. 10/727,306 ("the '306 Application"), and (iii) the provisional rejection of claims 27 and 28 under the judicially created doctrine of obviousness-type double patenting based on claims 18 and 19/18 of the '306 Application.

Appellant submits that the legal bases relied on by the Examiner as support for his anticipation rejection is misplaced. Further, the factual explanations the Examiner has advanced

to make out a *prima facie* case of anticipation do the opposite and support Appellant's position that claims 20-28 and 39 are patentable over Shigeru. Last, under the present facts, the Examiner's obviousness-type double patenting rejections are misplaced.

II. THE CASE LAW DOES NOT SUPPORT THE EXAMINER'S POSITION

In order to support the Examiner's anticipation rejection, he has relied on the following legal precedent to demonstrate "inherency" associated with the anticipatory reference, Shigeru. Specifically, the Examiner stated the following:¹

As noted from pages 11 and 12 of the Board decision on September 2, 2009:

"A single prior art reference that discloses, either expressly or inherently, each element of the claims invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. See *In re Cruciferous Sprout Litig.*, 301 F.3d 1943, 1949 (Fed. Cir. 2002)." See also *Verizon Services Corp. v. Cox Fibernet Virginia, Inc.*, 94 USPQ2d 1833 (Fed. Cir. 2010).

All of the cases cited in the quotation immediately above, except for the *Verizon* case, were cited by the Board of Patent Appeals and Interferences ("Board") in its decision of September 2, 2009 ("Decision").² The Examiner added the *Verizon* case, which by its date would not have been available for citation by the Board in the Decision. The *Verizon* case states the following with respect to the anticipation of patent claims based on inherency:³

For a prior reference to anticipate a patent, it must disclose each and every limitation of the claimed invention. *Schering Corp. v. Geneva Pharma., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) "[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in a single anticipating reference." *Id.* However, a patent claim "cannot be anticipated by a prior reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. 2003). "The standard for what constitutes proper enablement of a prior art reference for purposes of anticipation under section 102, however, differs from the enablement standard under section 112." *Rasmussen v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1325 (Fed. Cir. 2005). It is well-settled that utility and efficacy need not be demonstrated for a reference to serve as anticipatory prior art under section 102.

¹ Answer, section titled "Principle[s] of Law," page 8.

² The Board's Decision on Appeal is dated August 31, 2009, which the Examiner refers to in the Answer as the Board decision dated September 2, 2009.

³ *Verizon Services Corp. v. Cox Fibernet Virginia, Inc.*, 94 USPQ2d 1833, 1841 (Fed. Cir. 2010).

See Bristol-Myers Squibb Co. v. Ben Venue Labs., Ind., 246 F.3d 1368 (Fed. Cir. 2001); *In re Schoewald*, 964 F.2d 1122, 1124 (Fed. Cir. 1982).

Appellant would also like to bring to the Board's attention an additional legal precedent that is applicable when inherency is being considered for purposes of anticipation. This case addresses the issue of "necessarily present" where there are missing elements. More specifically according to this precedent, "[i]nherent anticipation requires the missing descriptive material is 'necessarily present,' not merely probable or possibly present in a prior art." *Trintec Industries, Inc. v. Top-USA Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Given the Examiner's failure to demonstrate Shigeru shows that all of the missing elements of the claimed invention are "necessarily present," only that the missing elements at best are possibly possible⁴ in view of Shigeru's support 1,⁵ then the Examiner has not met his burden under the applicable legal precedent to support his inherency contentions. Accordingly, Shigeru does not make out a *prima facie* case of anticipation as a matter of law.

III. THE EXAMINER'S ANALYSIS TO SUPPORT THE ANTICIPATION REJECTION IS FATALLY FLAWED

In the Answer at pages 9-12 in the section titled "Analysis," the Examiner states three bases he contends support Shigeru anticipating the claims of the present invention. Specifically, the Examiner stated the following:

At the outset, Appellant contended that Shigeru's support 1 is constructed of **rigid**, lightweight molded plastic (Brief p. 11).

The Examiner respectfully submits that Appellant's contention is unsupported by substantial evidence in the record. In fact, on the one hand, the term "**rigid**... [does] not... [appear] in the translation of [the] Shigeru reference. On the other hand, contrary to Appellant's subjective conjecture, Shigeru expressly teaches:

"In the internal structure of support 1, molded part 8 is a *light-weight plastic* and relieves fatigue of a portion of the hands in contact with the *cushion material* thereon by covering the hand. A

⁴ Appellant's statement that "all of the missing elements of the claimed invention are 'necessarily present,' only that the missing elements at best are possibly possible" is viewing the Examiner's contentions in the best possible light. Appellant submits that one skilled in the art would not find that the missing elements are even "possibly possible" in view of Shigeru's disclosure.

⁵ In light of substantial evidence to the contrary, the Examiner contends that the entire Shigeru support 1 is made of "flexible cushioning" material. As such, the Examiner alleges Shigeru reads on the claims of the present invention. As was demonstrated in the Appeal Brief and is demonstrated in this Reply Brief, one skilled in the art would find the Examiner's contentions are not supported by substantial evidence.

surface material 10 can be made with a cloth or with leather.”
(Translation p. 3) (Emphasis added)

“almost all of the parts are formed into curved surfaces and are covered all over with **flexible cushion** 9 when they are fixed to steering wheel 2. (Translation pp. 3 and 4) (Emphasis added)

Thus, [the] Shigeru reference as a whole discloses that the support 1 is [a] flexible cushion, *i.e.*, it is not *rigid*, molded plastic as evidenced by the quotation above. See MPEP §2143.03. Moreover, Shigeru’s device uses the cushion material to support a body part to relieve fatigue of the driver’s hand in the same manner as Applicant’s device. As noted, the cushion is soft as defined by [a] common standard dictionary. *Cf.*, unpublished *In re Opprecht*, 12 USPQ2d 1235 (Fed. Cir. 1989) (anticipation prior art needs not provide such explanation to anticipate when an artisan would know as evidenced by standard textbook). This fact is clearly evidenced by numerous references related to body supports, such as, *e.g.*, pillows, classified in Class 5 (beds) of the Office.

On the other hand, assuming *arguendo* that Shigeru’s support 1 is **rigid**, molded plastic as alleged, the Examiner respectfully submits that Shigeru’s support 1 still “reads on” the claimed element “*a rigid, semi-rigid or flexible, or deformable second section*” in claim 20. Put differently, Appellant’s tandem argument relied on the alleged “*rigid, molded plastic*” are unavailing due to the fact that Appellant’s appealed claim 20 does not preclude the **rigid**, lightweight molded plastic material.

Second, Appellant asserted that [the] Shigeru reference teaches away from the present invention. (Brief p. 13)

As noted from MPEP §2131.05, is well settled that:

“Arguments that the alleged anticipatory prior art is ‘nonanalogous art’ or ‘**teaches away** from the invention’ or is not recognized as solving the problem solved by the claimed invention, *[are] not ‘germane’* to a rejection under section 102.” *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)).

The question whether a reference “**teaches away**” from the invention is *inapplicable to anticipation analysis*. *Celeritas Technologies Ltd., v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. “The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.”). *See Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 119, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) (claimed composition that expressly excluded an ingredient by reference composition that optimally included the same ingredient); see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d

1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior reference that inherently met claim limitation of “sufficient aeration” even though reference taught away from air entrapment or purposeful aeration.).
(Emphasis added)

Third, Appellant asserted that Shigeru does not teach or suggest the present invention for the same reasons the Board found in the Board decision on September 2, 2009 that the present invention was not anticipated by US 2,118,580 (Van Arsdel) or US 1,575,828 (Laubach). (Brief pp. 14-17)

The Examiner respectfully submits that Appellant apparently overlooked the reasons the Board found that the present invention was anticipated by US 2,134,020 (Anson) on pages 14 and 15 of the above decision.

In the instant case, similarly to Anson, the Board should find that [the] Examiner has clearly found that Shigeru prefers to use a *flexible* cushioning composition/material to form the grip portion 1 that the Examiner is utilizing to read on the second structural aspect as seen in the rejection. An article of manufacture made from a cushioning *flexible* composition would inherently have a capability to deform out of interference. The amount of deformation out of interference would be dependent upon the resilience property of the cured light-weight plastic and not its form. Appellant tries to show that Shigeru does not inherently possess the characteristics of deforming out of interference because the grip would either not be used in operation (*i.e.*, the grip would not be locked or fixed in place and not movable from that place until the locking or fixing tension is removed) (Brief p. 17), or would not achieve the recited benefits (*i.e.*, deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel... when pressure from the portion of the vehicular operator’s body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel) (Brief p. 18). Neither argument outweighs the explicit disclosure that Shigeru’s device is manufactured from a material that is a *flexible* and thus would have an inherent property of being deformable. (Emphasis in original.)

Hereinafter, Appellant will demonstrate that each of the three bases the Examiner contends supports Shigeru anticipating the claims of the present application is fatally flawed. Therefore, Appellant submits that he has traversed each of the Examiner’s bases of rejection and the Board should reverse and remand these rejections, and direct the Examiner to reverse them and pass the application to issue.

A. THE EXAMINER’S FIRST BASIS IS FATALLY FLAWED

In the Answer, the Examiner’s first alleged basis to support rejecting the claims of the present application based on Shigeru for anticipation is that Shigeru’s support 1 is not

constructed of a rigid material as Appellant submits, but is instead made of a flexible cushioning material. To support his contention, the Examiner cites the following portions of Shigeru:

At the outset, Appellant contended that Shigeru's support 1 is constructed of **rigid**, lightweight molded plastic (Brief p. 11).

The Examiner respectfully submits that Appellant's contention is unsupported by substantial evidence in the record. In fact, on the other hand, the term "**rigid**"... [does] not... [appear] in the translation of [the] Shigeru reference. On the other hand, contrary to Appellant's subjective conjecture, Shigeru expressly teaches:

"In the internal structure of support 1, molded part 8 is a *light-weight plastic* and relieves fatigue of a portion of the hands in contact with the *cushion material* thereon by covering the hand. A surface material 10 can be made with a cloth or with leather."

(Translation p. 3) (Emphasis added)

"almost all of the parts are formed into curved surfaces and are covered all over with **flexible cushion** 9 when they are fixed to steering wheel 2. (Translation pp. 3 and 4) (Emphasis added)

Thus, [the] Shigeru reference as a whole discloses that the support 1 is [a] flexible cushion, *i.e.*, it is not *rigid*, molded plastic as evidenced by the quotation above. See MPEP §2143.03.

Before addressing the Examiner's statements in the quotation above, for convenience, Appellant provides certain Figures and a fuller citation from Shigeru, which are germane to the understanding of what this reference discloses, and they will show that the Examiner's understanding of Shigeru is incorrect.

The following reproduction of Figures 1-5 and 7 from Shigeru is provided to put the quotation immediately following the Figures into context:

Fig. 1

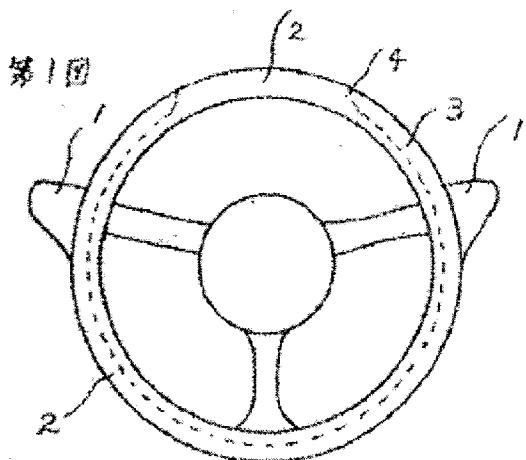


Fig. 2

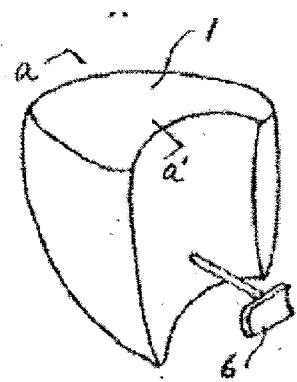


Fig. 4

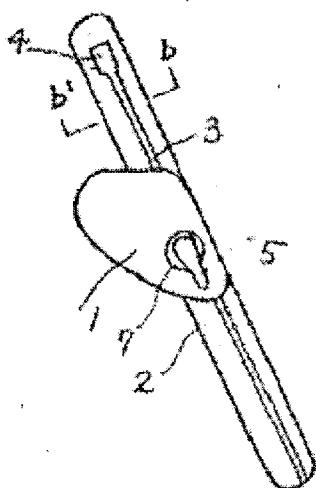


Fig. 3

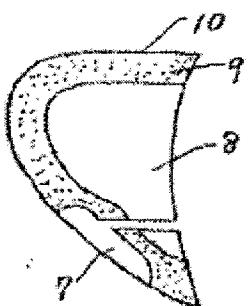
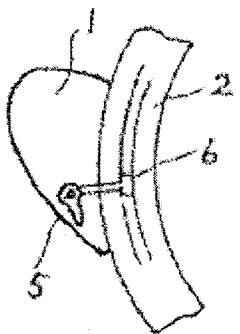
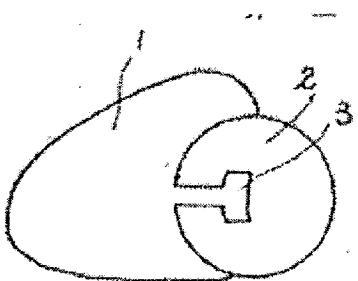


Fig. 7

Fig. 5



The following is the fuller citation from Shigeru:

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and fixed to a free place by the action of lever 5 and metal fitting 6 to make the hands stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 [is] fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it....*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a band 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered*

all over with flexible cushion 9 when they are fixed to steering wheel 2.

Therefore, the safety of the human body is thought to be high.

(Emphasis added)

As is shown in Figure 3, which is a cross-sectional view of support 1, molded plastic part 8 is **covered with cushion material 9**, and cloth or leather covering 10 to reduce hand slippage. Molded part 8 is a solid, rigid, molded piece of plastic that has groove 7 into which lever 5 is set. In Figure 3, the difference between cushion material 9 and solid, rigid, molded plastic part 8 is clearly shown. In Figure 3, solid, rigid, molded plastic part 8 has a consistent solid color shading, while cushion material 9 has dots to indicate it is a foam material. This would be understood by a person of ordinary skill in the art.

Lever 5 and metal fitting 6 are connected by a connecting rod. Metal fitting 6 is disposed in groove 3 cut in the peripheral edge of the steering wheel for locking support 1 to the steering wheel. When the driver locks or fixes solid, rigid, molded plastic part 8 to the steering wheel, the connecting rod between lever 5 and metal fitting 6 is disposed through the hole in solid, rigid, molded plastic part 8 that extends from groove 7 to the inside surface of solid, rigid, molded plastic part 8. In order to lock or fix solid, rigid, molded part 8 to the steering wheel, there must be considerable locking or fixing tension applied by lever 5 and metal fittings 6 to lock or fix support 1 to the steering wheel.

The Examiner contends that the entire support 1 is a “flexible cushion.”⁶ Appellant submits that the Figures and description of Shigeru above clearly demonstrate the Examiner is mistaken.

Referring to Shigeru, the only cushion material that is discussed is cushion material 9 that “covers” solid, rigid, molded plastic part 8. If solid, rigid, molded plastic part 8 was made of a flexible cushioning material as the Examiner contends, there would be no need for cushion material 9. Further, the Examiner fails to understand the latter part of the detailed description of Shigeru cited above by Appellant, which states why cushion material 9 covers solid, rigid, molded plastic part 8. As stated in the quotation from the detailed description of Shigeru, the parts are covered with cushion material 9 to protect the driver should he/she come in contact with the structure in an accident.

⁶ Anson, page 7.

Appellant submits that if solid, molded plastic part 8 was not made of rigid material, support 1 (1) would collapse under the locking or fixing tension and (2) would not be locked or fixed in place, and not movable from that place until the locking or fixing tension was removed. The translation is explicit that in order to move support 1 from one place to another, it must be unlocked or unfixed, moved, and relocked or refixed to the steering wheel by operation of lever 5, metal fitting 6, and groove 3. As such, support 1 includes solid, rigid molded plastic part 8 that is *covered* with cushion material 9, and cloth or leather 10.

Noting the foregoing, a person of ordinary skill in the art would understand that molded part 8, although made from a lightweight plastic material, would still be a solid, rigid structure as the Appellant contends. As such, Appellant has clearly demonstrated that the Examiner has a mistaken understanding of Shigeru, namely, that the support 1 structure is not made of “cushioning material.” Thus, the Examiner’s first basis for allegedly supporting that Shigeru anticipates the claims of the present application is fatally flawed and does not properly support the basis of an anticipation rejection based on Shigeru.

B. THE EXAMINER’S SECOND BASIS IS FATALLY FLAWED

In the Answer, the Examiner’s second alleged basis to support rejecting claims of the present application for anticipation based on Shigeru is that it is improper to contend an anticipatory reference can be alleged to teach away from a claimed invention. MPEP §2131.05.

Appellant notes the Examiner’s citation to MPEP §2131.05 regarding nonanalogous or disparaging prior art. However, Appellant wishes to point out that his statements in the Appeal Brief relating to Shigeru “teaching away” from the present invention relate to the fact that Shigeru fails to teach an element of the claims that the Examiner contends is present.

A review of MPEP §2131.05 indicates that if a prior art reference fails to teach each and every element of a claim either expressly or inherently that reference cannot anticipate the claim at issue. As Appellant pointed out in the Appeal Brief at pages 11-12, support 1 of Shigeru extends outward from a plane across the back of the steering wheel with a portion that protrudes behind that plane. This means that Shigeru will fail to expressly or inherently teach at least one element of the claimed invention as will be shown.

In the legal precedent cited by the Examiner, the prior art disclosed a configuration including the allegedly missing element(s), and then either taught away from that configuration or disparaged the configuration. Under the present facts, (1) Shigeru fails to provide an express

description of support 1 extending outward from a plane across the face of the steering wheel as in the present invention and (2) one skilled in the art would not find an inherent feature of Shigeru to be a structure that extends outward from a plane across the face of the steering wheel and that structure would be deformable out of interference with the driver's operation of the steering wheel as in the present invention.⁷

Appellant contends that the Examiner's reliance on MPEP §2131.05 is misplaced under the facts of the present application. As such, the Examiner's second basis that allegedly supports Shigeru anticipating the claims of the present application is fatally flawed and does not properly support the basis for an anticipation rejection based on Shigeru.

C. THE EXAMINER'S THIRD BASIS IS FATALLY FLAWED

In the Answer, the Examiner's third alleged basis to support rejecting the claims of the present application for anticipation based on Shigeru is that Shigeru is a pliable structure like the one disclosed in Anson, and not a fixed, rigid structure like those disclosed in Van Arsdel and Laubach. Appellant submits that Examiner's contention is unsupported by the substantial evidence as will be shown.

To support his rejection, the Examiner points to pages 14-15 of the Decision. Appellant submits that the portion of the Decision at pages 14-15 being relied on by the Examiner is the following:

The Examiner has found that Anson prefers the use of a pliable and semi-rigid composition to form the grip portion 11 that the Examiner is utilizing to read on the second structural aspect. [Citation omitted.] An article of manufacture made from a pliable or semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference. [Citation omitted.] The amount of deformation out of interference would be dependant upon the resilience property of the cured rubber and not its form.... In this case, the Examiner has good reason [citation omitted] to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, may, in fact, be an inherent characteristic of Anson's steering attachment. In such a case, the Appellant must provide evidence that Anson's steering attachment is not capable of deforming out of interference. [Citation omitted.]

Appellant submits that in the Appeal Brief he has clearly demonstrated that Shigeru, like Van Arsdel and Laubach, does not at least include the feature of support 1 deforming out of

⁷ Appellant submits this is further evidence that there is at least one element of the claims of the present application that is not "necessarily present" under applicable legal precedent.

interference with the operation of the steering wheel as set forth in the claims of the present invention.

At pages 11-18 of the Appeal Brief and in this Reply Brief, Appellant provides clear evidence to support that support 1 of Shigeru consists of a solid, rigid, molded plastic part 8 that is covered with cushion material 9, and cloth or leather 10. This clear evidence also shows that solid, rigid, molded plastic part 8 includes groove 7 into which lever 5 is set. Appellant has also demonstrated that in Figure 3 cushion material 9 is shown as a foam material that covers solid, rigid, molded plastic part 8.

There is clear evidence to support that in order to lock or fix solid, rigid, molded plastic part 8 to the steering wheel, there must be considerable locking or fixing tension applied by lever 5 and metal fittings 6 to lock or fix support to the steering wheel. Shigeru also is explicit that in order to move support 1 from one place to another, it must be unlocked or unfixed, moved, and relocked or refixed to the steering wheel by operation of lever 5, metal fitting 6, and groove 3. As such, a person of ordinary skill in the art would understand that if solid, molded part 8 was not made of rigid material, support 1 (1) would collapse under this locking or fixing tension and (2) would not be locked or fixed in place and not movable from that place until the locking or fixing tension was removed.

The above description of Shigeru's support 1 and the fixing of support 1 to the steering wheel are like the structures that connect to the steering wheels in Van Arsdel and Laubach. There is nothing in the description of Shigeru that would indicate it is pliable in any manner like the Anson structure.

With respect to Shigeru, support 1 is not a flexible cushion structure as the Examiner contends, and the Examiner has not come forward with substantial evidence to support his contention except through a clear misreading of Shigeru in order to attempt to find that support 1 is a "flexible cushion." Given that there is no support for the Examiner's contention that support 1 of Shigeru is a "flexible cushion," then his inherency position also is unsupported, thereby Appellant has demonstrated that the Examiner's third basis of support for his anticipation rejection based on Shigeru is misplaced.

Accordingly to the foregoing, Appellant has shown that the Examiner's third basis of support for alleging Shigeru anticipates the claims of the present application is fatally flawed and does not refute Appellant's position that Shigeru does not properly form a basis for an

anticipation rejection for the same reasons as Van Arsdel and Laubach as set forth by the Board in the Decision.

IV. OBVIOUSNESS-TYPE PATENTING REJECTIONS ARE IMPROPER

The Examiner has rejected claims 20-26 under the judicially created doctrine of obviousness-type double patenting based on claims 14-17, 24, and 27 of the '306 Application (co-pending with the present application), and rejected claims 27 and 28 under the judicially created doctrine of obviousness-type double patenting based on claims 18 and 19/18 of the '306 Application. In the Appeal Brief, Appellant has shown these rejections should be reversed given Appellant has filed a Terminal Disclaimer in the '306 Application based on the present application.

As stated in greater detail in the Appeal Brief at pages 18-21, according to the Manual of Patent Examining Procedures ("MPEP"), it is proper for an Examiner to reject claims of a pending patent application under the judicially created doctrine of obviousness-type double patenting when the following conditions are found with respect to two co-pending applications:

1. Nonstatutory Double Patenting Rejections

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

MPEP §804.I.B.1.

The provisions of the MPEP cited above and those cited by the Examiner in the May 13, 2010 Office Action to support his obviousness-type double patenting rejection are directed to

situations in which a terminal disclaimer has not been filed and accepted by the Examiner in one of the two applications. Since the Examiner has accepted the Terminal Disclaimer in the '306 Application based on the present application, the Examiner's obviousness-type double patenting rejection is traversed and should be reversed.

The Examiner has failed to substantively respond to Appellant's position that the ultimate result of the Examiner's requirement for crossing terminal disclaimers in the two applications would cause confusion as to terms of the patents issuing from the two applications. Accordingly, Appellant must surmise that the Examiner's preappeal position is still being asserted, which is that *each patent that issues will indicate it is subject to a terminal disclaimer with regard to the other, i.e., (1) the patent issuing from the present application would indicate a terminal disclaimer naming the '306 Application and (2) the patent issuing from the '306 Application would indicate a terminal disclaimer naming the present application.* Appellant submits that this would be improper if MPEP §804, subsection I.B.1., is followed, which would mean that the filing of the Terminal Disclaimer in the '306 Application would overcome any need to raise an obviousness-type double patenting rejection in the present application based on the '306 Application.

As stated in the Appeal Brief, Appellant submits that the second paragraph of MPEP §804, subsection I.B.1. would have applied to the present application and the co-pending '306 Application before the filing of a terminal disclaimer in one of the two applications.⁸ MPEP §804, subsection I.B.1. addresses the situation in which there are obviousness-type double patenting rejections in two applications with no terminal disclaimer having been filed. However, under the present facts, the obviousness-type double patenting rejection in the '306 Application has been overcome by the filing of the Terminal Disclaimer. This satisfies the requirement of the second paragraph of MPEP §804, subsection I.B.1. for the need of filing a terminal

⁸ The second paragraph of MPEP §804, subsection I.B.1. states:

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. (Emphasis added)

disclaimer in one of the applications and makes it improper to raise an obviousness-type double patenting rejection in the present application, which is the earlier-filed application.

Noting the foregoing, Appellant has traversed the Examiner's obviousness-type double patenting rejection as it has been applied to the present application and requests that it be reversed.

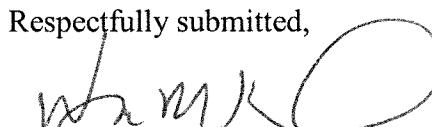
V. CONCLUSION

Appellant has demonstrated that (i) the Examiner does not meet the standards for reliance on inherency for purposes of finding that Shigeru anticipates the claims of the present application, (ii) the Examiner's three bases advanced in the Answer to support Shigeru as anticipating the claims of the present invention are fatally flawed and do not support a *prima facie* anticipation rejection, and (iii) the Examiner's obviousness-type double patenting rejections are improper in the present application. Given this, it is prayed that the Board reverse and remand the anticipation rejection applied to claims 20-28 and 39 under 35 U.S.C. §102 based on Shigeru, reverse and remand the obviousness-type double patenting rejections, and direct the Examiner to reverse these rejections and pass the application to issue.

The fees are believed due for filing this Reply Brief. However, if any fee is due or to credit any overpayment, please charge or credit our Deposit Account No. 08-0219, under Order No. 114089.121US1 from which the undersigned is authorized to draw.

Dated: September 30, 2010

Respectfully submitted,


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